

REMARKS

Claims 1-53 were presented for examination and were pending in this application. In a Final Office Action dated March 4, 2003, claims 1-53 were rejected. Applicant amends claims 1, 11, 16-18, 31-38, 40, 43-45, and 49. Applicant cancels claim 19 and adds new claims 54 and 55. Applicant now requests reconsideration and allowance of claims 1-18 and 20-55.

Applicant thanks Examiner for examination of the claims pending in this application and addresses Examiner's comments below.

Response to Examiner's Objections

Claims 31-43 were objected to under 37 C.F.R. § 1.75(a). Examiner noted that although these claims meet the requirements under 35 U.S.C. § 112, 2nd ¶, it is in the best interest of the patent community that Applicant takes into consideration some clarifying editorial suggestions. Applicant thanks Examiner for the editorial suggestions and has amended claims 31-37, 40, and 43-45 and added claims 54 and 55 to comply with Examiner's clarifying editorial suggestions. These clarifying amendments do not change the scope of the claims. Applicant submits that the basis for the objection to claims 31-43 has been obviated and the claims are now in condition for allowance.

The specification has been objected to under 37 C.F.R. § 1.75(d)(1) for failing to provide proper antecedent basis for the claimed subject matter of "the second presentation element" as recited in claims 31-43. Applicant respectfully traverses the rejection because the claimed subject matter is fully disclosed throughout the specification. For example, in page 9 at lines 3-5, the specification discloses "[t]he second portion 110 of the universal presentation device 101

includes a second presentation element. The second presentation element may be an electronic control device, for example, a computer pointing device element.” Therefore, Applicant respectfully requests withdrawal of the objection to the specification.

Response to Rejections Under 35 U.S.C. §112, Paragraph 2

Claims 1-15, 20-30, and 38-53 were rejected under 35 U.S.C. § 112, 2nd ¶, for indefiniteness with regard to the claimed limitation that “the electronic control device and the coherent light source may be operated simultaneously with each other ...” Claim 1 has been amended now reciting “the universal presentation device is configurable for simultaneously operating the electronic control device and the coherent light source” to further clarify that limitation without changing the claim scope. Similarly, claims 38 and 49 have been amended to include similar clarifying changes without affecting claim scope. In addition, claim 11 has been amended to correct an unintentional error of style.

The claimed simultaneous operation is repeatedly described in the specification. For example, the specification discloses that “the second embodiment of the universal presentation device 201 advantageously allows for simultaneous and independent use of the laser pointer element and the pointing device element”(page 18, lines 18-20); “the third embodiment of the universal presentation device 301 advantageously allows for simultaneous and independent use of the laser pointer element and the pointing device element, as well as a writing device element” (page 23, lines 6-8); etc. Applicant respectfully submits that claims 1-15, 20-30, and 38-53 are now in condition for allowance and requests favorable action from Examiner.

Response to Rejections Under 35 U.S.C. §102(e)

Claims 1, 20-21, 26-28, and 38-53 were rejected under 35 U.S.C. § 102(e) as being anticipated by Daniels (U.S. Patent No. 6,417,840 B1). Applicant respectfully traverses this rejection. Representative claim 1, as amended, recites in relevant part

A universal presentation device comprising:
an electronic control device ...; and
a coherent light source ...,
wherein the universal presentation device is configurable
for simultaneously operating the electronic control device and the
coherent light source, ...

In addition, independent claims 38 and 49, as amended, each recites similar limitations that require the coherent light source and the control device (or application control means in claim 38) to be able to be operated simultaneously with each other. Hence, there may be, for example, four operational states for the two functional devices, including: 1.) both off; 2.) control device on alone; 3.) coherent light source on alone; and 4.) both on. This advantageously allows the user to perform multiple functions at once, allowing for greater flexibility and efficiency in the use of the device.

Daniels does not disclose a universal presentation device that is configurable for simultaneously operating the electronic control device and the coherent light source. To the contrary, Daniels discloses an apparatus that allows only one of the laser or the mouse to be functional at any given time. (See Daniels; col. 4 lines 3-7 and 12-15.) Thus, Daniels fails to disclose at least one claimed limitation. Therefore, for at least this reason, Daniels does not anticipate the claimed invention of claims 1-15, 20-30, 38-48, and 49-53.

Further, claim 21 partially recites a “universal presentation device ... comprising a radio frequency receiver ...” A radio frequency receiver allows the universal presentation device to receive radio frequency signals from a radio frequency transmitter at the host computer or at another device. In contrast to the claimed invention, Daniels simply describes a cordless mouse that only transmits infrared or radio frequency signals. Specifically, Daniels states that in its cordless mouse,

provided a suitable frequency band is used which does not disrupt the operation of the computer, the signals from the signal **generator 41 may be transmitted** as radio frequency signals.

Daniels, col. 3, lines 41-45 (emphasis added). Daniels, fails to show a universal presentation device comprising a radio frequency **receiver** as Applicant claims. Therefore, for at least these reasons, Daniels fails to anticipate claim 21.

Thus, Applicant respectfully submits that independent claims 1, 38 and 49, along with all of the dependent claims are patentably distinct from Daniels.

Response to Rejections Under 35 U.S.C. §103

Claims 2-19, 22-25, and 29-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels in view of one of Liu, Mulla, Stork, Hu, and Shimada. Representative claim 1 recites in part “a universal presentation device configurable for simultaneously operating the electronic control device and the coherent light source.” Claims 2-15, 22-25, and 29 include the same limitation because they are either directly or indirectly dependent from claim 1. As previously discussed above, Daniels fails to disclose “a universal presentation device configurable for simultaneously operating the electronic control device and the coherent light source.” Liu, Mulla, Stork, Hu, and Shimada also fail to disclose this limitation. Therefore,

neither Daniels alone or in combination with Liu, Mulla, Stork, Hu, or Shimada anticipates the claimed invention of claims 2-15, 22-25, and 29. Applicant respectfully submits that claims 2-15, 22-25, and 29 are patentably distinct from the cited references and are in condition for allowance.

Claims 16 and 17 were rejected as being unpatentable over Daniels in view of Mulla.

Claims 17 and 18 have been amended to correct unintended grammatical and stylistic errors.

Claim 16 has been amended to advantageously recite

a modular universal presentation device comprising a first presentation module ... a second presentation module ... and a releasable locking assembly configured to releaseably couple the first presentation module with the second presentation module to form a unitary article.

This allows for the creation of customizable devices by allowing various modules to be combined together into a unitary device and later swapped out for a different module should the need arise. In the Final Office Action, in the "Response to Arguments" section, Examiner stated that there is no disclosure of "modularity, or the ability to connect two modules together for from a unitary device." Applicant respectfully disagrees and kindly invites Examiner to review the specification where the claimed combination of modules to form a unitary device is extensively disclosed. For example, the specification describes that

The modular universal presentation device 601 advantageously allows for independent presentation elements to be interconnected in a variety of different manners. For example, one portion may be a laser pointer element and another portion may be a pointing device element that may couple together. Alternatively, one portion may be removed and replaced with a writing instrument element. The number of configurations is very flexible and therefore provides a user with a powerful presentation device.

Page 33, lines 1-6. Further, to enable the modular design that allows coupling of modules, the specification describes in detail “locking or fastening systems” such as the spring fastener (page 32, lines 13-19) and provides several other examples of “locking or fastening systems” (e.g. protrusion and reciprocal notch assembly, spring ball assembly, snap tight assembly, threaded screw-like assembly – page 32, lines 19-22).

In addition, Daniels does not disclose modularity, or the ability to connect two modules together to form a unitary device. Daniels merely discloses a cordless mouse with an integrated laser pointer combined in a static and fixed fashion. There is no suggestion in Daniels that the modules may be separated and possibly rearranged or re-paired.

Similarly, Mulla simply describes an optical reader that allows a consumer to read and temporarily store a product identifier (“indicia” at col. 6, line 56) for later retrieving information from or purchasing the product over a network (e.g. the Internet). The optical reader may be in modular form insertable into a suitably configured writing implement housing of desired type (col. 7, lines 25-28). The optical reader in Mulla is different from the claimed “releasable locking assembly configured to releaseably couple the first presentation module with the second presentation module to form a unitary article” because it is simply the optical reader module inserted into a carrying housing. Mulla teaches that the writing implement portion of the housing should be small enough to allow maximum space for the optical sensor; “it is desirable to reduce the size of [the writing implement] as far as possible to allow maximum space for the reader module.” (Mulla, col. 7, lines 29-34).

Further, there is no motivation or suggestion to combine the modular form of the Mulla apparatus with the device in Daniels. In fact, there is no motivation to combine the IR mouse

with laser pointer of Daniels as a carrying case for the optical reader of Mulla. Moreover, Mulla teaches away from combining the large and bulky IR mouse and laser pointer of Daniels with the Mulla optical reader because, as previously stated, Mulla teaches that the writing implement in the housing should be **as small as possible** to allow for maximum space for the optical reader. Similarly, there is no motivation to combine the modular form of Mulla with the IR mouse with laser pointer of Daniels because only one of the mouse function or the laser pointer function can be used at one time in the Daniels' device (Daniels, col. 4, lines 12-15). As described in Daniels, the entire apparatus can be used either as a mouse only or alternatively as a laser pointer only without the need to separate the two functional components into modules as shown in Mulla.

Finally, Examiner cited Nerwing v. Erlichman, 168 U.S.P.Q. 177, 179 (PTO Bd. Of Int.1969) stating that this case "recognizes that the relocation of well known element is normally not desired toward patentable subject matter." This is not what this case supports. Rather, the case is directed to (1) the appropriateness of timing to bring certain issues during an interference proceeding, (2) the determination of whether a claim and a count are directed at the same invention, and (3) the determination that an integral structure may consist of various elements. Id., at 168-9. Hence, Applicant respectfully disagrees with Examiner's interpretation of the case and has included a copy for Examiner's review.

In sum, neither Daniels alone, Mulla alone or their improper combination disclose the claimed invention of claims 16 and 17. Applicant respectfully submits that claims 16 and 17 are patentable over Daniels alone or in combination for at least the reasons set forth above.

Claims 11-15, 18, and 19 were rejected as being unpatentable over Daniels in view of Stork. Claim 19 has been cancelled. Claims 11-15 are dependent from claim 1 and as discussed

above, neither Daniels alone, nor Stork alone, or their combination discloses all the elements of claim 1. Hence, as previously discussed, dependent claims 11-15 are not anticipated by the cited references alone or in combination. In addition, claim 18 recites “the modular universal presentation device in claim 16, wherein the second presentation module comprises a writing instrument element.” Claim 18 does not read on Daniels because Daniels fails to disclose the “modularity, or the ability to connect two modules together to form a unitary device” recited in claim 16. Similarly, claim 18 does not read on Stork, which discloses an apparatus for tracking a hand held writing instrument comprising three gyroscopes 126-128, because Stork fails to disclose the modularity elements recited in claim 16. Therefore, the combination of Daniels and Stork, assuming it is proper for argument sake, does not anticipate the claimed invention of claim 18. Consequently, Applicant submits that for at least the reasons set forth above claims 11-15 and 18 are patentable over the cited art and are now ready for allowance.

Claims 22-25 and 31-37 were rejected as being unpatentable over Daniels in view of Hu. Claims 22-25 are directly or indirectly dependent from claim 1. As previously discussed, Daniels fails to disclose all the elements recited in claim 1. In particular, Daniels fails to disclose “the universal presentation device ... configurable for simultaneously operating the electronic control device and the coherent light source.” Therefore, Daniels fails to anticipate the claimed invention of claims 22-25. Similarly, Hu fails to anticipate the claimed invention of claims 22-25 because Hu simply discloses an encoder wheel arrangement designed for use in, among other devices, an optical mouse. Like Daniels, Hu also fails to disclose the claimed “universal presentation device ... configurable for simultaneously operating the electronic control device and the coherent light source” of claims 22-25. Therefore, the combination of Daniels and Hu,

assuming it is proper for argument sake, does not anticipate the claimed invention of claims 22-25. Consequently, Applicant submits that for at least these reasons claims 22-25 are patentably distinct over the cited references and are now ready for allowance.

Additionally, claim 31 beneficially recites

A universal presentation device comprising
a radio-frequency communication unit ...;
a first presentation element ... configured to provide a first
control signal to the host system;
a second presentation element ... configured to provide a
second control signal to the host system;
a switch mechanism ...; and
a coherent light source.

Independent claim 31 advantageously includes a second presentation element in addition to the first presentation element and the coherent light source, effectively requiring three presentation elements. This allows even more functionality from the device. As noted, the second presentation element may be configured to provide a second control signal to the host system. This allows the device to provide another method of input into the host system and may increase the usability and efficiency of the device. Further, in Examiner's "Response to Arguments" with respect to claims 31-37 in the Final Office Action, Examiner stated that there is no disclosure for the second presentation element in the claims. Applicant respectfully disagrees and kindly invites Examiner to review the specification to find the ample disclosure of the "second presentation element" as already described in the "Response to Examiner's Objections" section above.

In addition, Daniels merely discloses a mouse with an integrated laser pointer. Thus, there are only two presentation elements. The third presentation element is not disclosed nor

contemplated in Daniels, neither is there a second control signal to the host computer. Therefore, Applicant respectfully submits that for at least these reasons claims 31-37 are patentable over Daniels. Similarly, Hu also fails to anticipate the three claimed presentation elements of claims 31-37 because Hu simply discloses an encoder wheel arrangement designed for use in, among other devices, an optical mouse. There is no mention in Hu of a second presentation element configured to provide a second control signal. In fact, Hu does not disclose any presentation elements since the disclosure of Hu relates to an encoder wheel assembly. Therefore, for at least this reason, claims 31-37 are patentably distinct over Hu.

Further, there is no motivation or suggestion to combine the optical mouse disclosed in Hu as a third presentation element with the IR mouse and laser pointer of Daniels. In fact, there is no motivation to combine the optical mouse of Hu with the IR conventional mouse, track ball, or touch pad and laser pointer of Daniels as a third presentation element because only one of an optical mouse, track ball, and touch pad would be sufficient to provide “a single operator the opportunity to control a computer using the conventional mouse signal indicating mouse movement and operation of the buttons and thereby control the computer” as described in Daniels (col. 4, lines 55-58). Hence, the combination of Daniels and Hu not only is improper, but also fails to anticipate the claimed invention of claims 31-37. Consequently, Applicant submits that claims 31-37 are patentably distinct from the cited references, alone or in combination, and are now in condition for allowance.

Lastly, claims 29 and 30 were rejected as being unpatentable over Daniels in view of Shimada. Claims 29 and 30 are dependent from claim 1 and as previously described above,

Daniels fails to anticipate all the claimed elements in claim 1. Therefore, Daniels fails to disclose the claimed invention of claims 29 and 30. In addition, Shimada fails to disclose the universal presentation device configurable for simultaneously operating the electronic control device and the coherent light source of claim 1. Shimada simply discloses an electronic device for entering information that implements a power saving scheme by slowing down the clock frequency to the CPU. Shimada also fails to disclose the “power management unit configured to turn off at least one of the electronic control device and the cohering light source.” The clock frequency controlling power saving scheme of Shimada would be incapable of affecting the power consumption of the coherent light source of the claimed invention because, for example, the power consumed by the claimed coherent light source would not be affected by the clock frequency. Therefore, for at least these reasons, claims 29 and 30 are patentable over Shimada. Further, combining the teachings of Daniels with the power saving scheme of Shimada, assuming it is a proper combination for argument sake, still fails to disclose the claimed universal presentation device configurable for simultaneously operating the electronic control device and the coherent light source of claims 29 and 30. Consequently, Applicant submits that claims 29 and 30 are patentable over the cited art, alone or in combination, and are now in condition for allowance.

Conclusion

In sum, Applicant respectfully submits that claims 1-18 and 20-55, as presented herein, are patentably distinguishable over the cited references, including references cited, but not applied. Therefore, Applicant kindly requests reconsideration and allowance of these claims.

In addition, Applicant respectfully invites Examiner to contact Applicant's representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

RESPECTFULLY SUBMITTED,
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